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In re Application of:

SCHOFIELD, Frederick, Andrew

U.S. Application No.: 08/952,474

PCT No.: PCT/GB96/01124

International Filing Date: 10 May 1996

Priority Date: 11 May 1995

Attorney's Docket No.: None

For: BUILDING COMPONENT

DECISION ON PETITION TO
REVIVE ABANDONED
APPLICATION UNDER 37
CFR 1.137(b)

This decision is issued in response to applicant's "Petition For Revival" filed on 08 January 2003. Deposit Account No. 07-2100 will be charged the \$650 small entity petition fee.

BACKGROUND

On 10 May 1996, applicant filed international application PCT/GB96/01124 which claimed a priority date of 11 May 1995 and which designated the United States. On 14 November 1996, a copy of the international application was communicated to the United States Patent And Trademark Office ("USPTO") by the International Bureau ("IB").

On 06 December 1996, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was extended to expire thirty months from the priority date, i.e., 12 November 1997 (11 November 1997 was a holiday).

On 12 November 1997, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 03 February 1998, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 was required. The Notification also informed applicant that the failure to submit these materials within one month of the date of the Notification would result in abandonment of the application.

On 10 October 1998, the DO/EO/US mailed a Notification Of Abandonment (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a response to the Notification Of Missing Requirements.

On 08 January 2003, applicant filed the Petition For Revival considered herein, with accompanying materials including an executed declaration in compliance with 37 CFR 1.497.

DISCUSSION

37 CFR 1.137(b) permits the filing of a petition to revive an abandoned application where the abandonment resulted from an unintentional delay. A grantable petition under this section must include: (1) the required reply, unless previously filed; (2) the petition fee required by law; (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional;" and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

Regarding item (1), the "required reply," section 711.03(c) of the Manual of Patent Examining Procedures states that:

[g]enerally, the required reply is the reply sufficient to have avoided abandonment, had such reply been timely filed.

Here, the application was abandoned based on applicant's failure to respond to the Notification Of Missing Requirements mailed 03 February 1998. The "required reply" was therefore a proper response to the Notification Of Missing Requirements, that is, an oath or declaration in compliance with 37 CFR 1.497. The 08 January 2003 submission includes such declaration. Thus, applicant has now made a submission which would have been "sufficient to have avoided abandonment" had it been made in a timely manner. Accordingly, applicant has submitted the "required reply." Item (1) is satisfied.

Item (2) is the petition fee required under 37 CFR 1.17(m). The Petition For Revival provided authorization to charge Deposit Account No. 07-2100 for the required petition fee. Item (2) is satisfied.

As for item (3), the Petition For Revival expressly states that the "entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional." It is noted that this application has been abandoned for an extended period of time. The USPTO is relying on petitioner's duty of candor and good faith and accepting the statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. See Changes to Patent Practice and Procedure, 62 Fed Reg at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 CFR 1.137(b) to the USPTO). Based on the above, item (3) is considered satisfied.

Under the terms of 37 CFR 1.137(c), the terminal disclaimer listed as item (4) above is not required for this application. Applicants have therefore satisfied all the requirements for a grantable petition under 37 CFR 1.137(b). The Petition For Revival is granted.

CONCLUSION

Applicant's Petition For Revival is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing in accord with this decision. The 35 U.S.C. 371 date is 08 January 2003.



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